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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,954	11/05/2003	Richard Andrew Backhouse	RSW920030178US1	8120

36736 7590 03/20/2007		EXAMINER	
DUKE W. YEE		TECKLU, ISAAC TUKU	
YEE & ASSOCIATES, P.C.			
P.O. BOX 802333		ART UNIT	PAPER NUMBER
DALLAS, TX 75380		2192	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/701,954	BACKHOUSE ET AL.
	Examiner	Art Unit	
	Isaac T. Tecklu	2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 November 2003</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-34</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-34</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>11/05/03</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to the application filed on 11/05/2003.

2.   Claims 1-34 have been examined.

Oath/Declaration

3.   The office acknowledges receipt of a properly signed oath/declaration filed on
11/05/2003.

Specification

4.   The use of the trademarks, such as JAVA, has been noted in this application (page 2, line

2). It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the

marks should be respected and every effort made to prevent their use in any manner which might

adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

6.   Claims 1-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

Claims 1, 12, 23 and 34 contains the trademark/trade name JAVA. Where a trademark or

trade name is used in a claim as a limitation to identify or describe a particular material or

product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph.

See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the

trademark or trade name cannot be used properly to identify any particular material or product.

A trademark or trade name is used to identify a source of goods, and not the goods themselves.

Thus, a trademark or trade name does not identify or describe the goods associated with the

trademark or trade name. In the present case, the trademark/trade name is used to

identify/describe JAVA and, accordingly, the identification/description is indefinite.

Claims 2-11, 13-22 and 24-33 are rejected upon dependency of the rejected base claims.

Claim Rejections - 35 USC § 101

7.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

1.   Claims 12-17 and 19-22 are rejected under 35 U.S.C. 101 because the claimed invention

is directed to non-statutory subject matter.

Claim 12 is non-statutory as being "A data processing system " without being supported

by hardware such as tangible computer storage or execution engine, which would enable one

skill in the art to construe that the apparatus is built from tangible product to carry out any

functionality being conveyed from the claim. Thus, the data processing system is computer

listings *per se*, i.e., the descriptions or expressions of the programs, are not physical "things."

They are neither computer components nor statutory processes, as they are not "acts" being

performed. Such claimed data processing system do not define any structural and functional

interrelationships between the data processing system and other claimed elements of a computer

which permit the computer program's functionality to be realized. In contrast, a claimed

computer- readable medium encoded with a computer program is a computer element which

defines structural and functional interrelationships between the computer program and the rest of

the computer which permit the computer program's functionality to be realized, and is thus

statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to

distinguish claims that define descriptive material per se from claims that define statutory

inventions.

Claims 13-17 and 19-22 are rejected for failing to cure the deficiencies of the above rejected non-statutory claim 12 above. See MPEP 2106.01(I).

2.   Claims 23-33 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter

3.   Claim 23 recites "computer-readable medium" defined to include wireless communication link (in page 26, lines 10-15). Thus, under the Interim Guidelines such media do not fall within one of the four statutory classes of 35 U.S.C. 101 (See Annex IV). Therefore, the above claims are non-statutory.

A computer-readable media is a tangible physical article or object, some form of matter, which a signal (infrared)/carrier wave is not. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also intended to require physical matter. A signal/carrier wave, a form of energy, does not fall within either of the two definitions of manufacture. Thus, a signal/carrier wave does not fall within one of the four statutory classes of Sec. 101.

See Annex IV (c) Electro-Magnetic Signals, Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (signed October 26, 2005) – OG Cite: 1300 OG 142. Online version can be retrieved at <http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>

Under the principles of compact prosecution, claims 41-43 have been examined as the Examiner anticipates the claims will be amended to obviate these 35 USC 101 issues. For example, A computer-readable physical storage medium...-

Claims 24-33 are rejected for failing to cure the deficiencies of the above rejected non-statutory claim 23 above.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-34 rejected under 35 U.S.C. 102(e) as being anticipate by Murren et al. (US

7,000,185 B1), hereinafter Murren.

As per claim 1, Murren discloses method in a data processing system for processing a

Java server page (e.g. FIG. 1A and related text), the method comprising:

translating the Java server page into a document object model object (e.g. FIG. 1A,

SOURCE JSP (101) to DOM (105) and related text);

configuring a set of visitor classes for invocation in a selected sequence (col. 11:55-65

"... component instantiates a tag object for ... object class ..." and e.g. FIG. 7, 701-702 and

related text) ; and

processing the document object model using the set of visitor classes in the selected

sequence to perform a desired set of custom functions on the document object model (col. 4:25-

35 "... traverses the DOM ..." and col. 9:10-25 "... passing the root of the node of the DOM

version of the source JSP ...").

As per claim 2, Murren discloses the method of claim 1 further comprising: validating

syntax in the Java server page (col. 4:1-20 "... adhere to syntax ..." and e.g. FIG. 2, element

203 and related text).

As per claim 3, Murren discloses the method of claim 1, wherein the set of visitor classes

for invocation in the selected sequence is defined in a configuration file (col. 12:50-58 "...

configuration file ..." e.g. FIG. 9, step 902 and related text).

As per claim 4, Murren discloses the method of claim 3, wherein the configuration file is

an extensible markup language file (e.g. FIG. 1A, XML (JSP) 103 and related text).

As per claim 5, Murren discloses the method of claim 3, wherein the selected sequence is defined in the configuration file (e.g. FIG. 1A, XML 102 and related text).

As per claim 6, Murren discloses the method of claim 1, wherein the document object model object includes a set of nodes and wherein the processing step includes: invoking methods in the
set of visitor classes on each node in the set of nodes in the selected sequence (col. 4:25-35 "... traverses the DOM ..." and col. 9:10-25 "... passing the root of the node of the DOM version of the source JSP ...").

As per claim 7, Murren discloses the method of claim 1 further comprising: storing results (e.g. FIG. 5, 505 and related text), as processing the document object model object occurs by selected method in the methods, in a hash map (col. 12:50-58 "... configuration file may contain a mapping of type ..."), wherein the results in the hash map are used by subsequently invoked methods (e.g. FIG. 7, 705 and related text).

As per claim 8, Murren discloses the method of claim 1, wherein the java server page is translated into a document object model object using a document object model generator (e.g. FIG. 1A, SOURCE JSP (101) to DOM (105) and related text).

As per claim 9, Murren discloses the method of claim 2, wherein the Java server page is validated using a Java server page translator (e.g. FIG. 2, 102 and related text and col. 4:1-20 "... adhere to syntax ..." and e.g. FIG. 2, element 203 and related text).

As per claim 10, Murren discloses the method of claim 9, wherein the Java server page translator invokes a visitor class to validate elements in the document object model object against syntax for a Java server page specification (e.g. FIG. 2, 102 and related text and col. 4:1-20 "... adhere to syntax ..." and e.g. FIG. 2, element 203 and related text).

As per claim 11, Murren discloses the method of claim 1, wherein results from processing by a first visitor class in the set of visitor classes are passed to a second visitor class in the set of visitor classes (col. 4:1-20 "... adhere to syntax ..." and e.g. FIG. 2, element 203 and related text).

As per claim 12, this is the data processing system version of the claimed method discussed above (Claim 1), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 13, this is the data processing system version of the claimed method discussed above (Claim 2), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 14, this is the data processing system version of the claimed method discussed above (Claim 3), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 15, this is the data processing system version of the claimed method discussed above (Claim 4), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 16, this is the data processing system version of the claimed method discussed above (Claim 5), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 17, this is the data processing system version of the claimed method discussed above (Claim 6), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 18, this is the data processing system version of the claimed method discussed above (Claim 7), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 19, this is the data processing system version of the claimed method discussed above (Claim 8), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 20, this is the data processing system version of the claimed method discussed above (Claim 9), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 21, this is the data processing system version of the claimed method discussed above (Claim 10), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 22, this is the data processing system version of the claimed method discussed above (Claim 11), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 23, this is the computer program product version of the claimed method discussed above (Claim 1), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 24, this is the computer program product version of the claimed method discussed above (Claim 2), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 25, this is the computer program product version of the claimed method discussed above (Claim 3), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 26, this is the computer program product version of the claimed method discussed above (Claim 4), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 27, this is the computer program product version of the claimed method discussed above (Claim 5), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 28, this is the computer program product version of the claimed method discussed above (Claim 6), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 29, this is the computer program product version of the claimed method discussed above (Claim 7), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 30, this is the computer program product version of the claimed method discussed above (Claim 8), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 31, this is the computer program product version of the claimed method discussed above (Claim 9), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 32, this is the computer program product version of the claimed method discussed above (Claim 10), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 33, this is the computer program product version of the claimed method discussed above (Claim 11), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

As per claim 34, this is the system version of the claimed method discussed above (Claim 1), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Murren.

Conclusion

6.　　Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac T. Tecklu whose telephone number is (571) 272-7957. The examiner can normally be reached on M-TH 9:300A - 8:00P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Isaac Tecklu
Art Unit 2192